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DEC 21 2005
OFFICE OF PETITIONS

In re Application of :
Coates et al. :
Application No. 09/448,086 :
Filed: November 23, 1999 : ON PETITION
Title of Invention: :
BONE GRAFTS :

This is a decision on the petition under 37 CFR 1.137(b), which also requests withdrawal of the holding of abandonment, filed April 18, 2005. The request to withdraw the holding of abandonment is properly treated under 37 CFR 1.181.

The petition under 37 CFR 1.181 is dismissed.
The petition under 37 CFR 1.137(b) is granted.

The above-identified application became abandoned for failure to timely reply to the final Office action, mailed August 4, 2001. The final Office action required a terminal disclaimer to overcome a double patenting rejection. The Office action set a statutory period for reply of three (3) months, and extensions of time under 37 CFR 1.136(a) were available.

Applicant filed a reply to the final Office action on January 17, 2002¹; however, the reply included a terminal disclaimer that was unacceptable as it was not executed by an attorney of record.

No proper reply having been received, the above-identified application became abandoned November 5, 2001. A Notice of Abandonment was mailed on May 1, 2002.

In response to the Notice of Abandonment, Applicant filed a petition on June 26, 2002, which, in the first alternative, requested withdrawal of the holding of abandonment based upon the January 17 reply.

¹ The reply included an authorization to charge extension-of-time fees as necessary.

That request was denied in a Decision mailed December 2, 2003, for failing to file a proper reply to the Office action.

The June 26, 2002 petition under 37 CFR 1.137(a)

The petition under 37 CFR 1.137(a) was dismissed in a decision mailed July 19, 2004. The Decision dismissing the petition concluded that a reasonable person in relation to their most important business would have ensured a proper reply, executed by a proper party in interest to the final Office action was filed on January 17, 2002.

The June 26, 2002 Petition under 37 CFR 1.137(b)

A decision on the petition under 37 CFR 1.137(b) was held in abeyance for a determination as to whether the Amendment, filed June 26, 2002, placed the application in condition for allowance.

The application file was forwarded to Technology Center Art Unit 3738 for a decision regarding the Amendment.

The instant petition to withdraw the holding of abandonment

Applicant files the instant petition under 37 CFR 1.137(b) and in the Statement of the Facts filed with the petition asserts that, after timely filing an Amendment and Response to the final Office action, along with the Terminal Disclaimer, he "never received an Advisory action apprising him of any deficiencies in the Response to the Final Office Action." Statement at p.3.

As iterated in the Decision denying the petition to withdraw the holding of abandonment mailed to Applicant on December 2, 2003, there is no basis for withdrawing the holding of abandonment². The petition to withdraw the holding of abandonment is dismissed.

²Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

The petition under 37 CFR 1.137(b)

With the instant petition, Petitioner paid the petition fee; submitted a Request for Continued Examination ("RCE"), and fee, and has previously filed a submission in the form of the Amendment filed January 17, 2002 (Certificate of Mailing dated November 14, 2001).

Accordingly, the petition is granted.

An electronic message is being transmitted to Technology Center 3738 to process the RCE and Amendment.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3232.



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Office of Petitions